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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,074	04/27/2001	Ernesto Zaccone	05788.0154	2298

7590 08/06/2003

Finnegan Henderson Farabow
Garrett & Dunner
1300 I Street NW
Washington, DC 20005

EXAMINER

ULLAH, AKM E

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

09/744,074

Applicant(s)

ZACCONE ET AL.

Examiner

Akm Enayet Ullah

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Telephone communication on 08-04-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8, 11-12</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Applicant cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Status of the Application

Claim 1-29 are pending in this application.

If applicant is aware of any prior art or any other co- pending application not already of record, he/she is reminded of his/her duty under 37 CFR 1.56 to disclose the same.

Drawings

This application has been filed on April 27, 2001 with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 10-11 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by (DE 32 24597 (SIMENS AG)).

Claims 1, 6 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by (FR 25 63 0427 (ELECTRITE DE FRANCE)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-3, 5, 7, 9, 12-13, and 15-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 32 24597 (SIMENS AG) and (FR 25 63 0427 (ELECTRITE DE FRANCE) in view of Dennis Laurence Lewis et al (GB 2 035 599).

In re to claims 2, wherein the material of the tubular structure is selected from metals, metals alloys and high-modules polymers; in re to claims 3, the tubular structure is made from aluminum or stainless steel are an inherent in Dennis et al and also very elementary teaching in this optical communication art as is shown by Dennis et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize such tubular structure in (DE 32 24597 (SIMENS AG) and (FR 25 63 0427 (ELECTRITE DE FRANCE) in view of Dennis et al., as claimed the instant invention.

It is within the level of ordinary skill in the art to couple an optical transmitter (i.e. a tubular structure made of different material) to a hybrid electrical – optical cable for overhead installations in order for installation along overhead lines for telecommunications and for electrical power distribution, particularly at low or medium voltage.

Therefore, one of ordinary skill in the art would have found it an obvious design choice to incorporate any hybrid electrical-optical cable for overhead installations having three insulated phase conductors helically wound around a supporting rope as disclosed in the above references.

Note that all the teachings need not to be express in the reference according to the case law as follows:

Art Unit: 2874

Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002)
Decided August 8, 2002. **The prior art disclosure need not be express in order to anticipate.** Even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent. **To establish inherency,** the extrinsic evidence must make clear that the missing descriptive matter **is necessarily present** in the thing described in the reference, and **that it would be so recognized by persons of ordinary skill.** Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akm Enayet Ullah whose telephone number is 703-308-4885.

The examiner can normally be reached on Mon.-Thurs. 6:30-5:00.

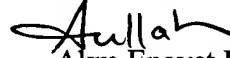
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 703-308- 4819. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7721 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Akm Enayet Ullah
Primary Examiner
Art Unit 2874

A.Ullah
April 21,2003